

REMARKS

The final Office Action mailed on May 7, 2007 has been reviewed and the Examiner's comments have been carefully considered regarding pending claims 1-34 and 42-60.

Claims 1-34 and 42-60 stand rejected under 35 USC §112. Applicants respond to the rejections below.

Examiner Interview

Applicants thank Examiner Khan and Primary Examiner Douyon for their time in conducting an interview with Mr. Tremitchell Wright and the undersigned on July 10, 2008.

Applicants hereby provide a statement of the substance of the interview in accordance with MPEP Section 713.04. The substance of the interview pertained to the remaining rejections to the claims, all under 35 U.S.C. §112, of this pending application. Applicants requested additional explanation as to the nature of rejections within the meaning of 35 U.S.C. §112. Also, the final Office Action states that "applicant's declaration under C.F.R. §1.132 is insufficient to overcome the rejections, and so Applicants also inquired as to whether there were any deficiencies in the previously filed Declaration under C.F.R. §1.132 of inventor, Mr. Tremitchell Wright, or in the attached Exhibits A and B (e.g. the numerical industry standards for electrical insulative and conductive materials). Examiners stated that the rejections were maintained based on application of law under 35 U.S.C. §112 and did not note any deficiencies in the Declaration. Applicants offered explanation as to the distinguishing facts and rationale of the rejected claims described in the case law cited in the Final Office Action as compared to those of the pending application. Agreement with respect to the patentability of the pending claims was not reached, however, the Examiners requested that Applicants submit explanation in writing in response to the final Office Action.

Rejection of Claims 1-34 and 42-60 Under 35 USC §112

All pending claims 1-34 and 42-60 stand rejected under 35 U.S.C. §112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-34 and 42-60 recite at least one of the following terms: "conductive polymer", "static charge dissipating coating", "static dissipating

shield", "static dissipating material compositions", "conductive material", and "static dissipating composition". The Examiner maintains that "the court has held that compositions are indefinite for being defined in terms of properties alone," citing, *Ex parte Spacht*, 165 USPQ 409 (PO Bd Pat App 1969); *Ex parte Slob*, 157 USPQ 172 (PO Bd Pat App 1976); *Ex parte Pulvari*, 157 USPQ (PO Bd Pat. App 1966).

Applicants respectfully submit that it is well settled that acceptability of the claim language in accordance with under 35 U.S.C. §112, second paragraph, depends on whether one of ordinary skill in the art would understand what is claimed, and the claim language need not be precise. (MPEP 2173.05(b)). Also, in considering the meaning of an invention as claimed, its meaning must be determined based on the context of the prior art and may include properties.

A Declaration under C.F.R. §1.132 and Exhibits of an inventor, Mr. Tremitchell Wright, was submitted on March 6, 2008 in conjunction with the Response to a non-final Office Action. Mr. Wright explained that electrical safety standards exist in the laundering and dry-cleaning industries. Exhibit A provides evidence that the movement or tumbling of both synthetic and natural fibers produces an electrical potential when humidity is low, such is often the case when non-aqueous fluids are used in the wash liquor. Exhibit B provides evidence that the numerical range of electrical resistivity which defines a conductive polymer according to one of ordinary skill in the art.

Applicants submit that the facts and rationale of the cases cited by the Examiner are easily distinguishable from those of the present case. The cited cases have the following characteristics in common: 1) all of the cases relate to claims which recites a composition of matter, and 2) all of the claims of these cited cases are deemed indefinite because, among other reasons, the claims are too broad in that they read upon material compositions that could not possibly be used to accomplish the purposes intended. Applicants' claims are directed to a method reciting a new combination of elements not found in the prior art. Furthermore, the recitation of a claim element does not render the claims indefinite where one of ordinary skill in the art would understand what is being claimed.

Ex parte Spacht, 165 USPQ 409 (PO Bd Pat App 1969), relates to a claim which was extremely broad. The claim recited a composition of matter which was an "organic material" susceptible to oxidation and containing an ingredient present in amounts sufficient to inhibit such

oxidation. The Board found that the claim would encompass materials which will behave differently than intended by the claim.

The claims of *Ex parte Slob*, 157 USPQ 172 (POBd Pat App 1976) are directed to a liquefiable substance. The claimed composition, recited only physical characteristics of a desired article and did not set forth specific compositions which would meet such characteristics. The Board found that claims directed to “a liquefiable substance having a liquification temperature from about 40°C to about 300°C and being compatible with the ingredients and the powder detergent composition” were properly rejected. The claim recited compounds by what it was desired that they do rather than what they were. Also, the claim was so broad that it reads upon materials that could not possibly be used to accomplish the intended purposes.

In *Ex parte Pulvari*, 157 USPQ (PO Bd Pat. App 1966) the Board held that when a substance of claim is expressed fully as a desired result of property, without further identification of any material that provides the result of the property, is outside the statute. The Court distinguishes case from *In re Feutterer* because there the claim was not merely a desired result but a new combination of substances with only one element or constituent of that combination being expressed as a result.

Furthermore, several recent cases have held that specific numerical dimensional or compositional limitations are not required to be specified in order to be held definite. In the case *In Re Corr*, the Federal Circuit held that numerical limitations were not required in specifying the ingredients of a composition claim. The claims recited the inclusion of “high styrene resin.” The Court found the claims to be definite because the styrene resin component of the composition was conventional and that many equivalents are known to the art. The Court even stated that although some routine experimentation might have been necessary to determine whether a particular styrene resin would perform adequately in the claimed composition, it would not be an unreasonable burden.

In the case *United States vs. Teletronics, Inc.* the claims recited the limitation of adjusting current so as to minimize fibrous tissue formation. The Federal Circuit stated that claim language would reasonably apprise those skilled in the art of the bounds of the claimed invention and is as precise as the subject matter permits.

Applicants reiterate that the pending claims recite a method of a laundering in an automatic laundering apparatus using well-defined material solvents in an environment that avoids the build up of an electrical potential which is unsafe during operation of the method. As such, the claims are not indefinite and one of ordinary skill in the laundering art would understand the metes and bounds of the claims.

Applicants response to the individual claim rejections were filed in the USPTO on March 6, 2008 in Response to the previous Office Action, and are summarized below.

Rejection of Claims 1-11, 33, 42-57 and 60

Claims 1-11, 33, 42-57 and 60 stand rejected under 35 USC §112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention in use of the language "conductive polymer".

Claims 1-11, 33, 42-57 and 60 recite a method to a new combination of steps for cleaning a fabric load in an automatic laundering apparatus. Applicants submit that the term "conductive polymer" is definite because conductive polymers are well-known to those of ordinary skill in the dry-cleaning arts. The term conductive polymer in the context of discussion throughout the written description is a material that dissipates static electricity so as to avoid the build up of an electrical potential which is unsafe during operation of the method. For example, the Declaration and Exhibits submitted by one of the inventors, Tremitchell Wright, explains that electrical safety standards exist in the laundering and dry-cleaning industries. Exhibit A points out that movement or tumbling of both synthetic and natural fibers produces an electrical potential when humidity is low, such is often the case when non-aqueous fluids are used in the wash liquor. Exhibit B provides the range of electrical resistivity which is needed by a conductive polymer by one of ordinary skill in the art.

One skilled in the art of dry-cleaning would know, or be able to test decisively, whether a compound has each one of these properties and falls into the metes and bounds of the method as claimed.

Applicants respectfully request withdrawal of the rejection of claims 1-11, 33, 42-57 and 60 which are not indefinite under 35 USC §112.

Rejection of Claims 1-11

Claims 1-11 are rejected under 35 USC §112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention in use of the language "static charge dissipating coating, a static dissipating shield."

Applicants respectfully submit that it is well settled that acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, and claim language need not be precise. (MPEP 2173.05(b)). Also, in considering the meaning of an invention as claimed, its meaning must be determined based on the context of the prior art.

Claims 1-11, 33, 42-57 and 60 recite a method to a new combination of steps for cleaning a fabric load in an automatic laundering apparatus. Applicants submit that the terms "static charge dissipating coating" and "a static dissipating shield" are definite because they are well-known to those of ordinary skill in the dry-cleaning arts. The terms "static charge dissipating coating" and "a static dissipating shield" within the context of discussion throughout the written description are materials which dissipate static electricity so as to avoid the build up of an electrical potential which is unsafe during operation of the method. As mentioned above, the Declaration and Exhibits submitted by one of the inventors, Tremitchell Wright, explains that electrical safety standards exist in the laundering and dry-cleaning industries. Exhibit A points out that movement or tumbling of both synthetic and natural fibers produces an electrical potential when humidity is low, such is often the case when non-aqueous fluids are used in the wash liquor. Exhibit B provides the range of electrical resistivity which is needed for a "static charge dissipating coating" and "a static dissipating shield" to those of ordinary skill in the art.

Applicants respectfully request withdrawal of the rejection of claims 1-11 which are not indefinite under 35 USC §112.

Rejection of Claims 12-23 and 58

Claims 12-23 and 58 are rejected under 35 USC §112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention in use of the language "static dissipating material compositions."

Applicants submit that the terms "static dissipating material compositions" are definite

because they are well-known to those of ordinary skill in the dry-cleaning arts. The term static dissipating material compositions in the context of discussion throughout the written description is a material that dissipates static electricity so as to avoid the build up of an electrical potential which is unsafe during operation of the method. As mentioned above, the Declaration and Exhibits submitted an inventor, Mr. Tremitchell Wright, explains that electrical safety standards exist in the laundering and dry-cleaning industries as described above. One skilled in the art of dry-cleaning would know, or be able to test decisively, whether a material composition falls into the metes and bounds of the method as claimed.

Applicants respectfully request withdrawal of the rejection of claims 12-23 and 58 which are not indefinite under 35 USC §112.

Rejection of Claim 15

Claim 15 is rejected under 35 USC §112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention in use of the language "conductive material."

Applicants submit that acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, and claim language need not be precise. (MPEP 2173.05(b)). One skilled in the art of dry-cleaning would know, or be able to test decisively, whether a compound has each one of these properties and falls into the metes and bounds of the method as claimed in claim 15 as described above with respect to claims 1-11, 33, 42-57 and 60

Applicants respectfully request withdrawal of the rejection of claim 15 which are not indefinite under 35 USC §112.

Rejection of Claims 16, 17, 27 and 52

Claims 16, 17, 27 and 52 are rejected under 35 USC §112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention in use of the language "static dissipating composition."

Applicants submit that the terms "static dissipating material compositions" are definite because they are well-known to those of ordinary skill in the dry-cleaning arts. The term static

dissipating compositions in the context of discussion throughout the written description is a material that dissipates static electricity so as to avoid the build up of an electrical potential which is unsafe during operation of the method. As mentioned above, the Declaration and Exhibits submitted by one of the inventors, Tremitchell Wright, explains that electrical safety standards exist in the laundering and dry-cleaning industries as described above. One skilled in the art of dry-cleaning would know, or be able to test decisively, whether a material composition falls into the metes and bounds of the method as claimed.

Applicants respectfully request withdrawal of the rejection of amended claims 16, 17, 27 and 52 which are not indefinite under 35 USC §112.

Rejection of Claims 24-34, 59 and 60

Claims are rejected under 35 USC §112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention in use of the language "predetermined quantity."

Applicants submit that language depends on whether one of ordinary skill in the art would understand what is claimed, and claim language need not be precise. (MPEP 2173.05(b)). Claims 24-34, 59 and 60 do not recite a composition of matter but recite a method which includes a new combination of method steps. In one embodiment the method provides for this auto-detection mechanism and optional heating of the fabric. The predetermined quantity of moisture can vary and the claims recite a method relating to the relative moisture content of the fabric. Applicants submit that a claim is not indefinite where relative amounts (i.e. "optionally heating when the moisture content is above a predetermined quantity") properly define the method.

Applicants respectfully request withdrawal of the rejection of amended claims 24-34, 59 and 60 which are not indefinite under 35 USC §112.

Rejection of Claims 24-34, 59 and 60

Claims 24-34, 59 and 60 are rejected under 35 USC §112, first paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention in use of the language "predetermined quantity."

Paragraph [0066] of the Applicants specification as filed describes at least one embodiment in which the control mechanism for the heater can sense or detect the moisture content in the clothing to increase the heat and reduce the moisture content prior to increase the heating capacity if the initial fabric load is a wet load, such as a rain soaked clothing or towels, etc. Commonly, the fabric load is generally dry prior to washing and before adding non-aqueous fluid. Accordingly, the machine may sense that the initial fabric load is a wet load and the consumer may select to initiate a wash cycle by selecting the wet load start cycle in which case the heater will dry the clothes before adding the non-aqueous fluid. Thus, in one embodiment the method provides for this auto-detection mechanism and optional heating of the fabric. Although the word "predetermined" is not literally mentioned, a literal basis exists as it is understood by the disclosure that the predetermined quantity can vary and the claims recite a method relating to the relative moisture content of the fabric. Applicants submit that a claim is not indefinite where relative amounts (i.e. "optionally heating when the moisture content is above a predetermined quantity") properly define the method.

Applicants respectfully request withdrawal of the rejection of amended claims 24-34, 59 and 60 which are not indefinite under 35 USC §112.

Conclusion

In summary, Applicants believes that this Amendment is fully responsive to the Final Office Action mailed on May 7, 2008, and that Applicants' claims include features that patentably define over the cited references. It is respectfully requested that for the foregoing reasons claims 1-34 and 42-60 of this application be found in condition for allowance. If the Examiner believes there are any further matters, which need to be discussed in order to expedite the prosecution of the present application, the Examiner is invited to contact the undersigned.

If there are any fees necessitated by the foregoing communication, please charge such fees to our Deposit Account No. 02-2051, referencing our Docket No. US20030459 (31480.6).

Respectfully submitted,

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Dated: August 7, 2008

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